

REMARKS

These remarks are in response to the Office Action mailed January 28, 2003. Claims 1-8 and 10 have been amended. Support for the amendments can be found throughout the specification and claims as originally filed. New claims 13-15 have been added. Support for new claim 13-15 can be found in the claims as filed and at page 7 of the specification. No new matter is believed to have been introduced.

Applicants respectfully request reconsideration and allowance of the pending claims.

I. OBJECTION TO THE SPECIFICATION

The specification is objected to for allegedly failing to reference SEQ ID Nos:9-11 by sequence identifiers in the specification per 37 C.F.R. §1.821. Applicants respectfully submit that sequence identifiers for SEQ ID Nos:9-11 can be found in the specification as originally filed at page 9, lines 8-9 and at lines 16-17. Accordingly, Applicants respectfully request withdrawal of the objection.

II. REJECTION UNDER 35 U.S.C. §112

Claims 2-7 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection.

The Patent Office rejects claims 2, 4, and 6 as allegedly indefinite because claims 2, 4 and 6 do not further limit claim 1. Applicants respectfully submit that claims 2, 4, and 6, as amended, overcome this rejection. Particularly, part (b) of each of these claims includes a range of deletions, substitutions, or additions of amino acids relative to the amino acid sequence recited in claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2, 4, and 6.

Claims 3, 5, and 7 are allegedly indefinite for the recitation of "stringent conditions". Applicants respectfully submit that claims 3, 5, and 7, as amended, do not contain recitation of stringent conditions. Furthermore, Applicants submit that new claims 13, 14, and 15, are not

indefinite as the claims recite the conditions considered stringent. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3, 5, and 7.

III. REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 1, 2, 4, 5, 8, and 10-12 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

The Office Action indicates that claims 1, 2, 4, 6, 8 and 10-12 are directed to all possible transformants obtainable by transforming any host whose polyhydroxybutanoic acid polymerase gene is disrupted, with a recombinant vector containing any polyester polymerase gene, any beta-ketothiolase gene, and any NADPH-acetoacetyl CoA reductase gene. Applicants respectfully submit that the Office is trying to limit the claimed invention to specific examples in view of a broader disclosure. The Office has the burden of proof to show why one of skill in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Int'f. 1987); MPEP §2163.04.

Applicants respectfully submit that relevant host cells are described in the specification, as filed, at page 5, lines 13-21, and include such host cells as *Pseudomonas*, *Bacillus*, *Escherichia*, *Ralstonia*, *Saccharomyces*, *Candida*, and the like. In addition, Applicants respectfully disagree that the host cell is "any host", but is rather a host cell that has a polyhydroxybutanoic acid polymerase gene.

Applicants also submit that one of skill in the art can easily identify polyester polymerase genes, beta-ketothiolase genes, and NADPH-acetoacetyl CoA reductase genes that are applicable to the claimed invention. The specification clearly identifies multiples genes that can be used to disrupt the polyhydroxybutanoic acid polymerase gene in the host cell. For example, pages 6-9, describe phaC1, phaC2, phbA, phbB, as well as polynucleotides that are capable of hybridizing to any one of the foregoing under stringent conditions. Accordingly, Applicants submit that they clearly described to one of skill in the art the description of genes useful in the invention.

In view of the amendments to the claims and the foregoing comments, Applicants respectfully request withdrawal of the §112, first paragraph rejection of claims 1, 2, 4, 6, 8, and 10-12.

Claims 9 and 10-12 stand rejected under 35 U.S. C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse this rejection.

The Office Action alleges that the invention of claim 9 is not enabled because the *Pseudomonas* sp. strain 61-3 (JCM10015) appears to be essential to the claim and is not fully disclosed or publicly known and freely available. Attached hereto is a 37 C.F.R. §1.132 Declaration attesting to the deposit of *Pseudomonas* sp. strain 61-3 (JCM10015). The specification has also been amended to reflect the deposit of the microorganism. Applicants believe that this overcomes the rejection. Accordingly, Applicants respectfully request withdrawal of the §112, first paragraph rejection.

IV. REJECTION UNDER 35 U.S.C. §102

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. §102(a) as allegedly anticipated by Matsusaki et al. (Applied Microbiology and Biotechnology, Vol. 53, pages 401-409, 2000). Applicants respectfully traverse this rejection.


Applicants respectfully submit that the Matsusaki et al. reference was published after Applicants' priority date of August 9, 1999. Attached hereto is an English translation of the priority document. The translation shows that Applicants were in possession of the claimed invention prior to the publication of the Matsusaki et al. reference. Thus, the Matsusaki et al. reference is unavailable as prior art. Accordingly, Applicants respectfully request withdrawal of the §102(a) rejection.

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Enclosed is a \$308 check for excess claim fees and for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,



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